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09/104,752    06/25/98    SCHAER    A    22963-1270

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EXAMINER

COHEN, L

ART UNIT

PAPER NUMBER

3739

DATE MAILED:

03/23/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/104,752

Applicant(s)

Schaer

Examiner

Lee S. Cohen

Group Art Unit

3739



☒ Responsive to communication(s) filed on Feb 22, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1, 2, 6-29, and 31-35 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☒ Claim(s) 34 is/are allowed.

☒ Claim(s) 1, 2, 6, 8-29, 31, 32, and 35 is/are rejected.

☒ Claim(s) 7 and 33 is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 22 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Method claim 22 depends upon an apparatus claim.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 16, 17, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Panescu et al in view of Nashef et al. The basic device is disclosed by Panescu et al. Applicant's attention is directed to columns 5-8 and , in particular, the Figure 9 embodiment. Panescu et al also discloses at column 6, lines 28-32 that the electrodes can be as small as 4 French in diameter and have lengths varying from about 2 mm to about 10 mm. Adjacent electrodes are spaced no farther apart than about 2.5 times an electrode diameter. Nashef et al discloses the use of a metal band about a temperature sensor to improve its performance. Applicant's attention is directed to Figure 1, elements 19 and 20. Various metals are disclosed for

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use as the heat conducting layer 19 as set forth at column 7, lines 3-16. The reference further discloses the use of an insulating jacket as detailed at column 13, lines 46-48. Accordingly, it would have been obvious to incorporate such features in Panescu et al to effect superior temperature sensing.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Panescu et al in view of Nashef et al as applied to claim 1 above, and further in view of Fleischman. The use of helical coil electrodes would have been an obvious design expedient in light of Fleischman's teaching at column 8, lines 31-51.

Claims 9-15, 18-22, 31, 32, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Panescu et al in view of Nashef et al as applied to claim 1 above, and further in view of Littmann et al. Littmann et al discloses the use of braided helical conductors as well as the particular core structure to have been well known in the art. Littmann et al also discloses the use of a distal tip coil member. Given Littmann's teachings, it would have been obvious to the skilled artisan to incorporate these features in the Panescu et al device to render it more flexible and maneuverable.

Claims 23-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Panescu et al in view of Littmann et al. The basic device is disclosed by Panescu et al. Applicant's attention is directed to columns 5-8 and , in particular, the Figure 9 embodiment. Panescu et al also discloses at column 6, lines 28-32 that the electrodes can be as small as 4 French in diameter and have lengths varying from about 2 mm to about 10 mm. Adjacent electrodes are spaced no farther apart

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than about 2.5 times an electrode diameter. Littmann et al discloses the use of a catheter shaft being about 0.76-1.27 mm in diameter. Littmann et al also discloses the use of braided helical conductors as well as the particular core structure to have been well known in the art. Littmann et al further discloses the use of a distal tip coil member. Given Littmann's teachings, it would have been obvious to the skilled artisan to incorporate these features in the Panescu et al device to render it more flexible and maneuverable. Such a modification would inherently create electrodes having diameters within the claimed range so as to be commensurate with the shaft diameter. In addition, the electrode spacing can be any distance less than 2.5 times the electrode diameter which would include the range 1 mm to 2 mm.

Claims 7 and 33 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 34 is allowed.


Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to Lee S. Cohen at telephone number (703) 308-2998.

  
**Lee Cohen**  
**Primary Examiner**